

REMARKS

This responds to the New Ground of Rejection presented in the Decision on Appeal having a notification date of September 20, 2010. As the Applicant is submitting amended claims in light of the New Ground of Rejection, Applicants respectfully request that the Appeal be terminated and the matter be remanded to the Examiner for further consideration. It should be noted that Applicants have not amended the claims for reasons of patentability but rather to expedite allowance of this application. Applicants reserve the right to pursue the claims in their form prior to the current amendments in one or more continuation applications.

Claims 1, 7, 15 and 17 are hereby amended. Claims 2, 3 and 16 are hereby canceled. No new claims have been added. As a result, claims 1, 4-10, 15, and 17-20 remain pending in this application.

The Rejection of Claims Under § 103

In the Decision on Appeal dated September 20, 2010, the Board set forth a New Ground of Rejection. Specifically, the Board rejected claims 1, 4-10, 15 and 18-20 under 35 U.S.C. § 103(a) as being unpatentable in view of the combination of Blackketter et al. (2002/0056129) in view of a reference titled, "Using a Browser Sniffer to Detect WebTV" (hereinafter referred to as "the WebTV reference"). For the reasons set forth below, claims 1, 4-10, 15 and 18-20 are not obvious in view of the combination of Blackketter and the WebTV reference.

Claims 1 and 4-6

Claim 1, as amended, is not obvious in view of the combination of Blackketter and the WebTV reference as applied by the Board, because neither reference describes or suggests 1) a server that hosts different versions of enhanced content compatible with a plurality of different types of set-top boxes, or, 2) a set-top box that forms, in accordance with received instructions, a request for a version of enhanced content compatible with the set-top box.

Applicant's claim 1 recites as follows:

A method to deliver enhanced content to a set-top box, the method comprising:

receiving a trigger included in a video signal input at said set-top box for indicating that enhanced content is available;
establishing a communication link between a server and the set-top box, the server hosting different versions of enhanced content compatible with a plurality of different types of set-top boxes;
receiving instructions at the set-top box for identifying the type of the set-top box, the instructions received from the server;
forming, in accordance with the received instructions, a request for a version of the enhanced content hosted at the server and compatible with the set-top box based on the type of set-top box; and
receiving enhanced content at the set-top box for generation of an enhanced display.

As amended, claim 1 involves establishing a communication link between a set-top box and a “server hosting different versions of enhanced content compatible with a plurality of different types of set-top boxes.” By way of example, Applicant’s specification refers to “WebTVTM, AOLTVTM, [and] UltimateTVTM” as examples of different types of set-top boxes.¹ This claim element is not described in Blackketter or the WebTV reference. Blackketter describes an interactive television trigger with a time attribute value, presumably for use with a **single type** of set-top box. The WebTV reference describes “using a browser sniffer to detect WebTV.”² More, specifically, the WebTV reference states, “you can use a browser sniffer script to deliver a certain Web page to your WebTV viewers and a different page to your Internet Explorer or Netscape visitors.”³ There is no evidence in the WebTV reference, nor is it reasonable to conclude, that the reference describes Applicant’s claimed, “server hosting different versions of enhanced content compatible with a plurality of different types of set-top boxes.”

Moreover, amended claim 1 additionally involves “forming, in accordance with the received instructions, a request for a version of ... enhanced content hosted at [a] server and compatible with the set-top box.” Neither Blackketter nor the WebTV reference describe this claim element. Applicant’s specification quite clearly describes two separate processes by which

¹ Applicant’s Specification, Page 2, Line 8.

² The Title of the reference is “Using a Web Browser Sniffer to Detect WebTV.”

³ The WebTV Reference

enhanced content can be delivered to a set-top box. The two processes are referred to in Applicant's specification as a "client side method" and a "server side method."⁴ Claim 1, which involves a set-top box "forming a request for a version of the enhanced content ... compatible with the set-top box," corresponds with a client side method. For instance, it is the set-top box that utilizes the instructions received from the server to identify its type and formulate a request for a version of enhanced content compatible with the type of set-top box. Contrary to what has been suggested by the Board, this claim element is not described by Blackketter or the WebTV reference.

In rejecting previously presented claim 1, the Board concluded that this claim element, as previously presented, was described in the WebTV reference. However, the Board referenced portions of the WebTV reference that describe a Perl CGI script, which a skilled artisan will immediately recognize as a server side solution, which does not involve a set-top box "forming, in accordance with the received instructions, a request for a version of ... enhanced content hosted at [a] server and compatible with the set-top box." Specifically, the Board states,

The WebTV reference discloses a browser sniffer that when combined with Blackketter discloses "receiving instructions at the set-top box for identifying a type of said set-top box" and "forming a request for said enhanced content from said server based on the type of set-top box," as claimed. A set-top box browser may retrieve Web content via an HTTP request, wherein the HTTP request includes a USER_AGENT attribute and the content is based on the USER_AGENT (WebTV reference, page 1). For example, in the CGI script written in Perl, if the USER_AGENT is "WebTV," the browser is redirected to the page "tv_index.html" that is specifically intended for WebTV users (page 2). In this case, the USER_AGENT attribute meets the limitation of a "type" of set-top box. The set-top box necessarily must have "receiv[ed] instructions ... for identifying a type of said set-top box" by determining and providing the USER_AGENT attribute in the HTTP request. Further, the HTTP request is "based on the type of set-top box" because it includes the USER_AGENT attribute.

⁴ Applicant's Specification, Summary of the Invention, Page 3, Lines 5-15

The Board's analysis is flawed in several respects. First, the Board improperly concludes that, "[t]he set-top box necessarily must have 'receiv[ed] instructions ... for identifying a type of said set-top box' by determining and providing the USER_AGENT attribute in the HTTP request." Applicant takes issue with this assertion as there is a difference between "receiving instructions" (e.g., at a set-top box, from a server) and being pre-programmed to provide an HTTP_USER_AGENT string. In any case, Applicant has amended claim 1 to clarify that the instructions for identifying the set-top box are received at the set-top box from the server hosting the enhanced content. A request that includes the USER_AGENT attribute, as described in the WebTV reference, is not a request that has been formed in accordance with instructions received from a server hosting enhanced content, as is claimed. For instance, there is nothing in the WebTV reference to indicate or suggest that the USER_AGENT attribute is included in a request as a result of having received instructions from a server to include the attribute in the request. To the contrary, the USER_AGENT attribute is likely included in every request, as is conventional with HTTP.

Second, a request with a USER_AGENT attribute, as described by the WebTV reference, is not a request "for a version of ... enhanced content hosted at [a] server that is compatible with the set-top box," as is claimed. As indicated above, claim 1 involves a client side method for delivering enhanced content to a set-top box. As such, the client forms a request for compatible content. The WebTV reference describes a CGI Perl Script that can be utilized at a server to select or customize content sent to a client based on the "HTTP_USER_AGENT string" included in the request received from the client.

For at least the reasons set forth above, claim 1 is not obvious in view of Blackketter and the WebTV reference. As claims 4-6 depend from claim 1, these claims are also patentable over the combination of Blackketter and the WebTV reference.

Claims 7-10, 15 and 18-20

Independent claims 7 and 15, as amended, are not obvious in view of the combination of Blackketter and the WebTV reference as applied by the Board, because neither reference describes or suggests a "server hosting different versions of enhanced content compatible with a plurality of different types of set-top boxes," as recited in both claims 7 and 15.

Both of independent claims 7 and 15 have been amended to indicate that the claimed server hosts different versions of enhanced content compatible with a plurality of different types of set-top boxes. By way of example, Applicant's specification refers to "WebTVTM, AOLTVTM, [and] UltimateTVTM" as examples of different types of set-top boxes.⁵ This claim element is not described in Blackketter or the WebTV reference. Blackketter describes an interactive television trigger with a time attribute value, presumably for use with a **single type** of set-top box. The WebTV reference describes "using a browser sniffer to detect WebTV."⁶ More, specifically, the WebTV reference states, "you can use a browser sniffer script to deliver a certain Web page to your WebTV viewers and a different page to your Internet Explorer or Netscape visitors."⁷ As such, the WebTV reference at best implicitly suggests a server that hosts content for users of one type of set-top box (e.g., a WebTV set-top box) and content for other users with conventional computers (e.g., non-set-top boxes) executing Internet Explorer or Netscape web browser applications. There is no evidence in the WebTV reference, nor is it reasonable to conclude, that the reference to "Internet Explorer and Netscape visitors" involves set-top boxes. Consequently, it is an error to suggest or conclude that the WebTV reference describes Applicant's claimed, "server hosting different versions of enhanced content compatible with a plurality of different types of set-top boxes."

For the reasons set forth above, claims 7 and 15 are not obvious in view of the combination of Blackketter and the WebTV reference. As claims 8-10 and 18-20 depend from claims 7 and 15, respectively, these claims are also patentable over the combination of Blackketter and the WebTV reference.

Claim 17

It is unclear from the New Ground of Rejection set forth in the Decision on Appeal how claim 17 was rejected. In any case, as claim 17 is dependent upon claim 15, claim 17 is patentable over the combination of Blackketter and the WebTV reference for at least all of the same reasons as claim 15.

⁵ Applicant's Specification, Page 2, Line 8.

⁶ The Title of the reference is "Using a Web Browser Sniffer to Detect WebTV."

⁷ The WebTV Reference

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 660-2014 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No.19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402--0938
(408) 660-2014

Date 11/22/2010

By Nathan P. Elder
Nathan P. Elder
Reg. No. 55,150